

JAN 16 2007

Serial No. 10/647,262

Amendment dated January 16, 2007

Atty. Docket No. DOC.016DC

Reply to Office action of July 13, 2006

REMARKS

Prior to entry of this amendment, claims 15-30, 38, 41-46 and 51-60 are currently pending in the subject application. Claim 38 is withdrawn from consideration. Claims 61-64 have been added. Claims 15, 53 and 57 are independent.

Applicants request, in the next Office action, that the Examiner indicate the acceptability of the drawings filed on August 26, 2003.

Applicants appreciate the Examiner's consideration of applicants' Information Disclosure Statement filed December 20, 2004.

Claims 15-30, 41-46 and 51-64 are presented to the Examiner for further or initial consideration on the merits.

A. Introduction

In the outstanding Office action mailed on July 13, 2006, the Examiner rejected claims 21-25 and 44 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention; rejected claims 57 and 59 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,330,799 to Sandor et al. ("the Sandor et al. reference"); rejected claims 15-17, 19-26, 30, 41-45, 51, 52, 58 and 60 under 35 U.S.C. § 103(a) as being unpatentable over the Sandor et al. reference; rejected claims 18, 27-29, 46 and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over the Sandor et al. reference in view of U.S. Patent No. 5,771,218 to Feldman et al. ("the Feldman et al. reference"); and rejected claims 15-30, 41-46 and 51-60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,610,166 to Harden et al. ("the Harden et al. reference").

B. Asserted Indefiniteness Rejections of Claims 21-25 and 44

In the outstanding Office action, the Examiner rejected claims 21-25 and 44 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended the claims as suggested by the Examiner. Therefore, it is respectfully submitted that this rejection be withdrawn.

C. Asserted Anticipation Rejection of Claims 57 and 59

In the outstanding Office action, the Examiner rejected claims 57 and 59 under 35 U.S.C. § 102(b) as being anticipated by the Sandor et al. reference. Independent claim 57 has been

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amended. It is respectfully submitted that claim 57, as well as claim 59 depending therefrom, is allowable over the Sandor et al. reference for at least the reasons set forth below.

Claim 57 now recites, in part:

a master including an optical element on a substantially planar surface thereof . . . and initially bringing a portion of the substantially planar surface of the master into contact with only a portion of the support substrate, . . . and then bringing the entire substantially planar surface of the master simultaneously into contact with the support substrate.

While the Sandor et al. reference may disclose using a cylinder to imprint an optical element, which may inherently bring only the master into contact with only a portion of the support substrate, it is respectfully submitted that the Sandor et al. reference fails to disclose or suggest using a master with an optical element on a substantially planar surface that initially contacts the substrate and then fully contacts the substrate, as now recited in claim 57. As noted, for example, on page 19, line 26 to page 21, line 5, such staged contact may reduce or eliminate air bubbles between the master and the substrate.

Therefore, it is respectfully submitted that claim 57 now clearly recites the present invention over the Sandor et al. reference. Claim 59 depends from claim 57, and is further believed to be allowable for at least the reasons claim 57 is believed to be allowable. Therefore, it is respectfully requested that this rejection be withdrawn.

D. Asserted Obviousness Rejection of Claims 15-17, 19-26, 30, 41-45, 51-52, 58 and 60

In the outstanding Office action, the Examiner rejected claims 15-17, 19-26, 30, 41-45, 51, 52, 58 and 60 under 35 U.S.C. § 103(a) as being unpatentable over the Sandor et al. reference. Independent claims 15 and 57 have been amended. It is respectfully submitted that claims 15 and 57, as well as the remaining claims depending therefrom, are allowable over the Sandor et al. reference.

Claim 15 now recites, in part:

making a master including a plurality of optical elements on a substantially planar surface thereof,
simultaneously imprinting a replica of said plurality of optical elements in a material by applying the substantially planar surface of the master to the imprintable material.

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In the Sandor et al. reference, the master may include a plurality of optical elements, but these are not simultaneously imprinted. It is respectfully submitted that even making the elements of the Sandor et al. reference on a small scale would not result in simultaneously imprinting the plurality of optical elements on the substantially planar surface of a master on the imprintable material, as now recited in claim 15. Therefore, it is respectfully submitted that claim 15 clearly defines the present invention over the Sandor et al. reference.

Claims 17, 19-26, 30, 41-45, and 51 depend from claim 15, and are further believed to be allowable for at least the reasons claim 15 is believed to be allowable. Claims 58 and 60 depend from claim 57, and are further believed to be allowable for at least the reasons claim 57 is believed to be allowable, as discussed above. Therefore, it is respectfully requested that this rejection be withdrawn.

E. Asserted Obviousness Rejection of Claims 18, 27-29, 46 and 53-56

In the outstanding Office action, the Examiner rejected claims 18, 27-29, 46 and 53-56 under 35 U.S.C. § 103(a) as being unpatentable over the Sandor et al. reference in view of the Feldman et al. reference. This rejection is respectfully traversed for at least the reasons set forth below.

First, it is noted that the Feldman et al. reference fails to provide the teachings noted above as missing from the Sandor et al. reference. Second, the instant specification claims priority under 35 U.S.C. § 120 to the Feldman et al. reference. Thus, the Feldman et al. reference does not qualify as prior art. Finally, with respect to claims 28, 29, 46 and 53-56, there is no disclosure or suggestion in the Feldman et al. reference of tacking the master and the support substrate once aligned, as discussed, for example, on page 21, line 25 to page 23, line 20, of the original specification.

Therefore, it is respectfully requested that this rejection be withdrawn.

F. Obviousness-Type Double Patenting Rejection of Claims 15-30, 41-46 and 51-60

In the outstanding Office action, the Examiner rejected claims 15-30, 41-46 and 51-60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,610,166 to Harden et al. ("the Harden et al. reference"). A terminal disclaimer is submitted concurrently herewith, thereby obviating this rejection.

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G. New Claims

Claims 61-64 have been added. Claim 61 recites a limitation removed from claim 15. Claims 62-64 recite further details of the present invention, as disclosed, for example, page 18, lines 6-14 of the original specification.

H. Conclusion

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.

Respectfully submitted,

LEE & MORSE, P.C.

Date: January 16, 2007


Susan S. Morse, Reg. No. 35,292

Attachment: Terminal Disclaimer

LEE & MORSE, P.C.
3141 FAIRVIEW PARK DRIVE
SUITE 500
FALLS CHURCH, VA 22042
703.207.0008 TEL
703.207.0003 FAX

PETITION and
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If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying papers may also be charged to Deposit Account No. 50-1645.

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